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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,685	08/24/2000	Michinori Hirota	36595:165847	2576

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EXAMINER	
CHERUBIN, YVESTE GILBERTE	
ART UNIT	**PAPER NUMBER**
3713	19

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No. 09/643,685	Applicant(s) HIROTA, MICHINORI	
	Examiner Yveste G. Cherubin	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8 and 10-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8 and 10-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. This office action is in response to the RCE of the US Application No. 09/643,685 filed on October 9, 2003. It has been noted that claims 1-7 and 9 are cancelled, claims 8 and 10 amended and claims 11-16 added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "said remainder of symbols" on page 3, 1st line. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claims 11-13 are being rejected as being dependent upon rejected claim 8.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

a. Claims 10, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 4,715,604) – referred to hereinafter as Okada '604) in view of Okada (US Patent 5,083,785 – referred to hereinafter as Okada '785).

As per claim 10, 14-15 Okada' 604 discloses a slot machine comprising a display and shift or move means for moving or shifting and displaying various kinds of symbols on a set of reels, as shown in Fig 1. During a game, each reel is caused to rotate and is stopped at one of the possible stop positions in each of which it displays corresponding symbols neighboring to each other, as shown in Fig 1, to a player through a window or an easy-viewable profile. When all the reels stop, a win decision is made based on the combinations of symbols stopping on the winning line or lines. However, Okada'604 fails to disclose a random number generator for generating random numbers divided into a plurality of random number segments ....." In reference to Fig 2, the Examiner interprets the "random number segments" of the claimed invention as being the "series of numerical value" cited in Okada '785, 3:35-38, 55-64. In the instant invention, just like the random number generator is divided into a plurality of segments, each numerical value in Okada constitutes of a series of numerical values ranging from the minimum numerical value "1" to maximum numerical value "4096" and wherein those numerical data correspond to a plurality of small, middle and big wins. Okada'785 further teaches a random number sampler (26) for sampling the numerical values generated by the random number generator, 3:28-48; a storage means (29) for storing table data having a plurality of predetermined reference values, 3:49-50, 4:1-4; a stop control means (36) for controlling the stop of the shift and display means to have a set

of symbols stopped and displayed on the basis of the winning state, 4:5-49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of dividing the random number into segments as taught by Okada'785 into the Okada '604 in order to provide a plurality of winning chances to players. As per claim 16, Okada '604 in view of Okada '785 disclose the claimed invention as substantially as explained above. However, Okada '604 in view of Okada '785 fail to disclose the use of symbol marks to form a specified symbol mark and wherein said specified symbol mark includes a first semi circular symbol mark formed in the shape of an upper half of a circular configuration and a lower half of a circular configuration to complete a circle in cooperation with a said first semi-circular symbol mark. Using such configuration to display symbols would have been a matter of design choice. For example, it's known to have half of a watermelon being used as a symbol. However, having it arranged and displayed in a way to form a circular shape would have been a matter of choice. Respectfully, the Examiner does not see the difference between the symbol marks of Okada and the symbol marks of this instant claim limitation since the symbol marks of both devices are applying the same function, which is to display possible winning combinations. Besides, a symbol is a symbol and can be represented by anything one wants it to be. Relating or associating that symbol to whatever winning combination to fit one needs would have been a matter of design choice. Whatever symbols one decides to use to display the different possible winning combinations would be an obvious matter of design choice. The difference between the symbols of this claimed invention and the symbols in the Okada reference is size and

shape of the symbols. It would have been an obvious matter of design choice to enlarge the symbols for better view, since such a modification would have involved a mere change in the size of the component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art, In re Rose, 105 *USPQ 237 (CCPA 1955).*

Allowable Subject Matter

4. Claims 8, 11-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

5. Applicant's arguments filed on August 11, 2003 in respect to claim 10 have been fully considered but they are not persuasive. The examiner notes on page 17, lines 9-16 that the Applicant argues limitations that are not recited in the claims. Nowhere in the claim 10, does it recite ".....a game function that inactivates the stop feature when the game is in the big prize winning state". The specification is not the measure of the invention. Therefore, limitations contained therein cannot be read into the claims for the purpose of avoiding the prior art. In re Spocrck, 55 CCPA 743, 386 F 2d 924, 155 USPQ 687 (1968).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, T. Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

December 11, 2003
ygc

T. Walberg

Teresa Walberg
Supervisory Patent Examiner
Group 3700